

Group (IV), claims 28-30, directed to a method of manufacturing surface crosslinked superabsorbent polymer. Applicants also are required to elect a single species for (a)-(e) as set forth in the Office Action.

Applicants hereby elect the invention represented by the claims of examiner's Group I, namely, claims 1 through 19 inclusive, with traverse, for examination on the merits at this time. Applicants also elect, with traverse, the species (a) acrylic acid, (b) poly(acrylic acid), (c) montmorillonite, (d) claim 18 wherein R_1 is hydrogenated tallow, R_2 is benzyl, and R_3 and R_4 are methyl, and (e) methyl benzyl di(hydrogenated tallow) ammonium bentonite. Claims readable on applicants' elected species are claims 1-30.

It is submitted, however, that all claims 1 through 30, and all species, should be examined at this time. According to PCT Rule 13, claims of different categories with common special technical features do not lack unity. Also, see Example 1 in PCT Gazette, page 52, Part 2 I. (copy enclosed).

In the present invention, the common special technical feature in all claims is adding clay to superabsorbent polymers during the surface-crosslinking step as recited in claims 4 and 28. There may be a lack of unity only if this common technical feature lacks of novelty or is obvious.

The same applies to the species (a) to (e), which are preferred embodiments in the dependent claims. The dependent claims share all features of the independent claim as a common special technical

feature. Also, see PCT Gazette, page 49, Part 1(c) (copy enclosed).

Unity of invention in the present application is evidenced further by the International Search Report. In particular, all claims were searched. The standards regarding unity of invention that apply to the International Searching Authority *also* apply to the U.S. Patent Office with respect to this application. Therefore, the unity of invention requirement is fulfilled, and any reliance upon independence or distinctness of the invention is not relevant under the PCT.

In addition, M.P.E.P. §1893.03(d) provides that when making a lack of unity of invention requirement, the examiner *must* "explain why each group lacks unity with each other group (i.e., why there is no single general inventive concept) specifically describing the unique special technical feature in each group." A group of inventions is considered linked as to form a single general inventive concept when a technical relationship exists among the inventions that involves at least one common or corresponding special technical feature. That common special technical feature is present in *all* of claims 1-30.

The examiner has not provided *proper* reasons why each group lacks unity with each other group specifically describing the unique special technical feature in each group as required in M.P.E.P. §1893.03(d). The examiner has considered only the type of claims, i.e., product by process, method of absorbing, absorbent articles, and method of manufacturing, without considering the special technical features recited in, and common to, each claim, as set forth above. Fur-

thermore, it must be noted that the claims of examiner's Groups II and III, i.e., claims 20-27, *depend* from claim 1 and therefore *must* share a common technical feature with the claims of examiner's Group I. Furthermore, the method steps of Groups I and II are identical with the only difference being that Group I claims particles prepared by the process.

Similarly, the examiner's requirement to elect species (a)-(e) is not supported. Each species recited in the dependent claims has the single general inventive concept of adding clay to superabsorbent polymers during the surface crosslinking step. This single inventive concept is present *regardless* of the identity of the species (a)-(e).

Moreover, the groups do not lack unity of invention with each other. Group II relates to a method of absorbing an aqueous medium using the particles of Group I, and Group III relates to absorbent articles containing the particles of Group I. Group IV relates to a method of manufacturing the particles of Group I that are prepared using *that* method. Therefore, for all the reasons set forth above, Groups I-IV have a unity of invention.

The Office Action fails to indicate whether Groups I-IV are classified in different classes or subclasses, but, even if differently classified, the inventions are not independent for the reasons set forth above *and* because the product by process set forth in claims 1 through 19, and the methods and absorbent articles set forth in claims 20-30 are so closely related that a search for applicants' product

by process would necessarily encompass a search for applicants' absorbent article and method claims.

In addition, there is no evidence that a search and examination directed to all claims would be a *serious burden* on the examiner, as is required by M.P.E.P. §803. ("If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions." and "There must be a serious burden on the examiner if restriction is not required.")

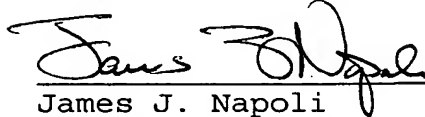
Because search and examination of the entire application can be made without serious burden on the examiner, it would be wasteful of the time, effort, and resources of both the applicants and the Patent Office to prosecute the product by process, method, and absorbent article claims in separate applications. Search and examination of all groups of claims in a single application would be much more efficient than requiring the Patent Office to prosecute the product by process, method, and absorbent article claims in separate applications. Search and examination of all groups of claims in a single application would be much more efficient than requiring the Patent Office and applicants to do so in separate applications. Accordingly, it is submitted that all claims and species should be examined at this time.

Reconsideration and withdrawal of the restriction requirement are respectfully requested. An early action of the merits on all claims is solicited.

Respectfully submitted,

MARSHALL, GERSTEIN & BORUN LLP

By

A handwritten signature in black ink, appearing to read "James J. Napoli", is written over a horizontal line.

James J. Napoli
(Registration No. 32,361)
Attorneys for Applicants
6300 Sears Tower
233 South Wacker Drive
Chicago, Illinois 60606
(312) 474-6300

Chicago, Illinois
November 22, 2005

S-03/2001 (E)
30 August 2001

PCT Gazette – Section IV

49

ANNEX B UNITY OF INVENTION

Part 1

Instructions Concerning Unity of Invention

(a) **Unity of invention.** Rule 13.1 deals with the requirement of unity of invention and states the principle that an international application should relate to only one invention or, if there is more than one invention, that the inclusion of those inventions in one international application is only permitted if all inventions are so linked as to form a single general inventive concept.

(b) **Technical Relationship.** Rule 13.2 defines the method for determining whether the requirement of unity of invention is satisfied in respect of a group of inventions claimed in an international application. Unity of invention exists only when there is a technical relationship among the claimed inventions involving one or more of the same or corresponding "special technical features." The expression "special technical features" is defined in Rule 13.2 as meaning those technical features that define a contribution which each of the inventions, considered as a whole, makes over the prior art. The determination is made on the contents of the claims as interpreted in light of the description and drawings (if any).

(c) **Independent and Dependent Claims.** Unity of invention has to be considered in the first place only in relation to the independent claims in an international application and not the dependent claims. By "dependent" claim is meant a claim which contains all the features of another claim and is in the same category of claim as that other claim (the expression "category of claim" referring to the classification of claims according to the subject matter of the invention claimed—for example, product, process, use or apparatus or means, etc.).

(i) If the independent claims avoid the prior art and satisfy the requirement of unity of invention, no problem of lack of unity arises in respect of any claims that depend on the independent claims. In particular, it does not matter if a dependent claim itself contains a further invention. Equally, no problem arises in the case of a genus/species situation where the genus claim avoids the prior art. Moreover, no problem arises in the case of a combination/subcombination situation where the subcombination claim avoids the prior art and the combination claim includes all the features of the subcombination.

(ii) If, however, an independent claim does not avoid the prior art, then the question whether there is still an inventive link between all the claims dependent on that claim needs to be carefully considered. If there is no link remaining, an objection of lack of unity *a posteriori* (that is, arising only after assessment of the prior art) may be raised. Similar considerations apply in the case of a genus/species or combination/subcombination situation.

(iii) This method for determining whether unity of invention exists is intended to be applied even before the commencement of the international search. Where a search of the prior art is made, an initial determination of unity of invention, based on the assumption that the claims avoid the prior art, may be reconsidered on the basis of the results of the search of the prior art.

(d) **Illustrations of Particular Situations.** There are three particular situations for which the method for determining unity of invention contained in Rule 13.2 is explained in greater detail:

- (i) combinations of different categories of claims;
- (ii) so-called "Markush practice"; and
- (iii) intermediate and final products.

Principles for the interpretation of the method contained in Rule 13.2, in the context of each of those situations are set out below. It is understood that the principles set out below are, in all instances, interpretations of and not exceptions to the requirements of Rule 13.2.

Examples to assist in understanding the interpretation on the three areas of special concern referred to in the preceding paragraph are set out below.

(j) Rule 13.3 is not intended to constitute an encouragement to the use of alternatives within a single claim, but is intended to clarify that the criterion for the determination of unity of invention (namely, the method contained in Rule 13.2) remains the same regardless of the form of claim used.

(k) Rule 13.3 does not prevent an International Searching or Preliminary Examining Authority or an Office from objecting to alternatives being contained within a single claim on the basis of considerations such as clarity, the conciseness of claims or the claims fee system applicable in that Authority or Office.

Part 2

Examples Concerning Unity of Invention

The application of the principles of unity of invention is illustrated by the following examples for guidance in particular cases.

I. Claims in Different Categories

Example 1

Claim 1: A method of manufacturing chemical substance X.

Claim 2: Substance X.

Claim 3: The use of substance X as an insecticide.

Unity exists between claims 1, 2 and 3. The special technical feature common to all the claims is substance X.

Example 2

Claim 1: A process of manufacture comprising steps A and B.

Claim 2: Apparatus specifically designed for carrying out step A.

Claim 3: Apparatus specifically designed for carrying out step B.

Unity exists between claims 1 and 2 or between claims 1 and 3. There is no unity between claims 2 and 3 since there exists no common special technical feature between the two claims.

Example 3

Claim 1: A process for painting an article in which the paint contains a new rust inhibiting substance X including the steps of atomizing the paint using compressed air, electrostatically charging the atomized paint using a novel electrode arrangement A and directing the paint to the article.

Claim 2: A paint containing substance X.

Claim 3: An apparatus including electrode arrangement A.

Unity exists between claims 1 and 2 where the common special technical feature is the paint containing substance X or between claims 1 and 3 where the common special technical feature is the electrode arrangement A.

However, unity is lacking between claims 2 and 3 since there exists no common special technical feature between them.